

REMARKS

Claims 1, 3-18, 20-35 and 37-38 are pending in this application. Claims 2, 19 and 36 had been previously canceled. Claims 1, 18 and 35 are independent. Claim 1 has been amended. Applicants respectfully request reconsideration of the rejected claims in light of the amendment and remarks presented herein, and earnestly seek timely allowance of all pending claims.

Claim Objections

Claim 1 has been objected to because the Examiner finds that claim 1 still contains reference numerals: "said first information selection unit (102)". Applicants appreciate the Examiner pointing out this error and have amended claim 1 to eliminate the reference to (102). As such, it is respectfully requested that this objection be withdrawn.

Claim Rejections under 35 U.S.C. § 101

Claims 1-7 have been rejected under 35 U.S.C. § 101 because the Examiner asserts the claimed invention is allegedly directed to non-statutory subject matter because the Examiner believes claims 1-7 recite software units, and lacks hardware. This rejection is respectfully traversed.

Claims 1-7 recite statutory subject matter under 35 U.S.C. § 101 which includes "new and useful process, **machine, manufacture**, or composition of matter" (emphasis added). The claims clearly recite an apparatus and thus constitute statutory subject matter. If the Examiner maintains this rejection, Applicants request legal authority be shown for this position demonstrating that an apparatus is not statutory subject matter.

Furthermore, on page 7 of Applicants' Specification, the "hardware configuration as shown in Fig. 1 is a hardware structure of a general mobile phone, and the hardware configuration of the information output device in accordance with the present invention". Figure 1 shows the various components or units of the hardware configuration as claimed in independent claim 1. Thus, claims 1-7 recite statutory subject matter.

Therefore, it is respectfully requested this rejection be withdrawn.

Claim Rejections under 35 U.S.C. § 103 – Yamamoto, Watanabe

Claims 1, 3-11, 13, 14, 17, 18, 20-28, 30, 31, 34, 35, 37 and 38 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yamamoto (“Yamamoto”, U.S. 2004/0008373) in view of Watanabe (“Watanabe”, U.S. 2003,0202585). This rejection is respectfully traversed.

Independent claim 1 recites, *inter alia*, “**creating outline presenting information corresponding to each of a plurality of multimedia data in parallel**”. Independent claims 18 and 35 similarly recite this feature. The Examiner asserts that Yamamoto teaches or suggests this feature (*See Office Action, Page 5*). However, the means the Examiner points to “an image forming means for forming images for said attachment file” is actually a scanner that acquires images by scanning the documents, i.e. forms the images for attachment (*See ¶ 089*). There is no discussion in Yamamoto of creating *outline presenting information corresponding to multimedia data*, much less creating outline presenting information corresponding to each of a plurality of multimedia data *in parallel* as similarly recited in claims 1, 18 and 35.

Independent claim 1 recites, *inter alia*, “**said presentation unit presents alternative information before completion of said outline presenting information creation process, said alternative information including at least intermediate information under course of creation in said outline presenting information creation unit in stages according to respective said outline presenting information creation process and another set of information**”. Independent claims 18 and 35 similarly recite this feature. The Examiner admits that Yamamoto does not teach or suggest this feature (*See Office Action, Page 6*). The Examiner relies on Watanabe to cure the deficiencies of Yamamoto. However, Watanabe does not teach or suggest the above-mentioned feature. The examiner asserts that Watanabe’s “display of frames” is equivalent to the “intermediate information”. Watanabe discusses frames that are used for *motion picture retrieval* (*See ¶ 005*). In fact, the passage cited by the Examiner in Watanabe to teach or suggest this feature only discusses obtaining the position of a feature frame based on index information, and when a new feature frame is required in the process of image retrieval, extracting the new feature frame (*See ¶ 101*). Watanabe is wholly devoid of “said presentation

unit presents alternative information before completion of said outline presenting information creation process, said alternative information including at least intermediate information under course of creation in said outline presenting information creation unit in stages according to respective said outline presenting information creation process and another set of information" as recited in claims 1, 18 and 35.

Moreover, the Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. (*See MPEP § 2141*). The Examiner asserts that it is "obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Watanabe with Yamamoto, since it would have allowed a user to view an outline of data while obtaining the outline of data. There is no support for this conclusory statement as Yamamoto relates to *e-mail transmissions* while Watanabe relates to *motion picture retrieval*. Neither discuss obtaining or viewing outline data.

For at least the reasons stated above, independent claims 1, 18 and 35 are patentably distinct from Yamamoto and Watanabe. Claims 3-11, 13, 14, 17, 20-28, 30, 31, 34, 37 and 38 are at least allowable by virtue of their dependency on corresponding allowable independent claim.

Accordingly, it is respectfully requested to withdraw this anticipation rejection of claims 1, 3-11, 13, 14, 17, 18, 20-28, 30, 31, 34, 35, 37 and 38 based on Yamamoto and Watanabe.

Claim Rejections under 35 U.S.C. § 103 – Yamamoto, Watanabe, Aiyama

Claims 12 and 29 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yamamoto ("Yamamoto", U.S. 2004/0008373) in view of Watanabe ("Watanabe", U.S. 2003,0202585) further in view of Aiyama ("Aiyama", U.S. 2002/0076245). This rejection is respectfully traversed. Aiyama does not remedy the noted deficiencies of

Yamamoto and Watanabe and thus cannot correct the defects of the Examiners rejection based solely on Yamamoto and Watanabe.

Accordingly, it is respectfully requested to withdraw this obviousness rejection of claims 12 and 29 based on Yamamoto, Watanabe and Aiyama.

Claim Rejections under 35 U.S.C. § 103 – Yamamoto, Watanabe, Menich

Claims 15, 16, 32 and 33 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yamamoto (“Yamamoto”, U.S. 2004/0008373) in view of Watanabe (“Watanabe”, U.S. 2003,0202585) further in view of Menich (“Menich”, U.S. 2003/0187632). This rejection is respectfully traversed. Menich does not remedy the noted deficiencies of Yamamoto and Watanabe and thus cannot correct the defects of the Examiners rejection based solely on Yamamoto and Watanabe.

Accordingly, it is respectfully requested to withdraw this obviousness rejection of claims 15, 16, 32 and 33 based on Yamamoto, Watanabe and Menich.

CONCLUSION

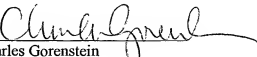
Entry of the above amendments is earnestly solicited. An early and favorable first action on the merits is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Charu K. Mehta, Reg. No. 62,913, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: June 11, 2009

Respectfully submitted,

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